REMARKS

This application has been amended in a manner that is believed to place it in condition for allowance at the time of the next Official Action.

Claims 1-19 are pending in the present application. Claims 1-9 have been amended to address the formal issues raised in the outstanding Official Action. Claims 10-19 have been added. Support for claims 10-19 may be found generally throughout the specification and in the original claims. In particular, support may be found for new claims 10-19 in the present specification at page 9, lines 15-25; page 10, lines 16-24; and page 11, lines 13-24.

In the outstanding Official Action, claims 1-9 were rejected under 35 USC §112, second paragraph, for allegedly being indefinite. Applicants believe the present amendment obviates this rejection.

In imposing the rejection, the Official Action alleged that the phrase "alkyl ether type of nonionic surfactant" was indefinite because the term "type" did not allow one skilled in the art to ascertain the metes and bounds of the claim. While applicants believe that the term may be broad, applicants believe that the term is definite to one of ordinary skill in the art.

Nevertheless, in the interest of advancing prosecution, claim 1 has been amended to delete the term "type". Thus, in

view of the above, applicants believe that the claimed invention is definite to one of ordinary in the art.

Claims 1-5 and 7-9 were rejected under 35 USC §102(b) as allegedly being anticipated by AOKI et al. 5,382,295. This rejection is respectfully traversed.

Applicants respectfully submit that AOKI et al. do not disclose the specific combination of phosphonic acids with nonionic surfactant which serves to improve the effectiveness and removal of particles as outlined in the present specification. Indeed, the present specification teaches that a polyoxyalkylene alkyl ether surfactant can adjust a contact angle with a liquid composition to a hydrophobic substrate within a desired range, leading to improved wettability and improved removal of particles. A liquid composition containing the surfactant is also less foamable during cleaning or other handling processes (see page 12, lines 1-6).

In particular, applicants note that AOKI et al. do not teach nor suggest a particular surfactant in terms of whether it is a cationic surfactant, anionic surfactant, nonionic surfactant, or a mixture. As a result, the publication does not each and every recitation of the claimed combination.

Thus, in view of the above, applicants believe that AOKI et al. fail to anticipate the claimed invention.

Claims 1-6 were rejected under 35 USC §102(b) as allegedly being anticipated by SATOSHI et al. This rejection is respectfully traversed.

SATOSHI et al. is directed to a liquid detergent composition for cleaning clothes stained with hard to remove dirt (e.g., oil stains) by including a specific nonionic surfactant and an organic phosphonic acid composition.

Applicants believe that SATOSHI et al. would have actually lead one of ordinary skill in the art away from obtaining the claimed invention. The present invention is concerned with a liquid composition for cleaning a hydrophobic substrate which is used for cleaning a substrate having a surface area in which a water droplet exhibits a contact angle of 60° or more.

Thus, the present invention provides a cleaning composition which enables the adjustment of a contact angle with a liquid composition to a hydrophobic substrate within a desired range, leading to improved wettability resulting in excellent particle removable performance for the substrate.

SATOSHI et al. teach the use of specific compounds and do do not disclose nor suggest the claimed combination. Furthermore, SATOSHI et al are concerned with a different concentration of surfactant, and do not teach a droplet of an aqueous solution containing the surfactant having a contact angle of 50° or less.

Thus, in view of the above, applicants believe that SATOSHI et al. fail to anticipate or render obvious the claimed invention.

Claims 1-9 were rejected under 35 USC §103(a) as allegedly being unpatentable over BESSHO et al. This rejection is respectfully traversed.

BESSHO et al. provide a cleaning agent for semiconductor parts. However, BESSHO et al. do not provide the necessary motivation or reasonable expectation of success to one of ordinary skill in the art to select a surfactant having a contact angle as recited in the claims.

As a result, the claimed invention stands somewhat in contrast to BESSHO et al, wherein BESSHO et al. disclose a cleaning agent containing a polymer having sulphonic acid (salt) groups and carboxylic acid (salt) group in addition to a sulfonic acid (salt) group containing a polymer, a phosphonic acid compound, or a surfactant. Thus, BESSHO et al rely on the addition of a polymer and do not specifically teach or suggest the claimed combination.

In view of the above, applicants believe that one of ordinary skill in the art would lack the motivation to modify the BESSHO et al. reference so as to obtain the claimed invention.

At this time, the Examiner's attention is respectfully directed to new claims 10-19. In claims 10-19, the contact angle of the nonionic surfactant is determined on a surface where a

water droplet without nonionic surfactant exhibits a contact angle of 60° or more, and the surface is independent of "a surface area" of the substrate as recited in independent claims 10 and 19. Thus, the contact angle helps to specify the nonionic surfactant.

Applicants respectfully submit that none of the above-identified publications disclose or suggest the claimed nonionic surfactant. As the publications also fail to disclose or suggest that the claimed composition results in a liquid composition for cleaning a hydrophobic substrate, whereby particles adhering to a hydrophobic surface of the substrate can be removed, applicants believe that the above-identified publications, alone or in combination with each other, fail to disclose or suggest the claimed invention.

At this time, the Examiner is reminded that a critical step in analyzing obviousness pursuant to 35 U.S.C. §103(a) is casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, only guided by the publications and then-accepted wisdom in the field. Close adherence to this methodology is important in cases where the invention itself may prompt an Examiner to "fall victim to the insidious effect of a hindsight syndrome, wherein that which only the invention taught is used against its teacher." Indeed, to establish a prima facie case of obviousness, there must be some motivation, suggestion or teaching of the desirability of making

the specific combination that was made by the applicant. *In re Kotzab,* 217 F.3d 1365, 1369-70, 55 USPQ 2d 1313, 1362 (Fed. Circ. 2000). The fact that the prior art could be so modified would not have made the modification itself obvious unless the cited publications themselves suggested the desirability of the modification. *In re Gordon,* 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Circ. 1984).

In light of the lack of a motivation, suggestion or teaching of the desirability of making the claimed combination, applicant believes that the publications fail to disclose or suggest the claimed invention.

In view of the present amendment and foregoing remarks, therefore, applicants believe the present application is in condition for allowance at the time of the next Official Action. Allowance and passage to issue on that basis is respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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